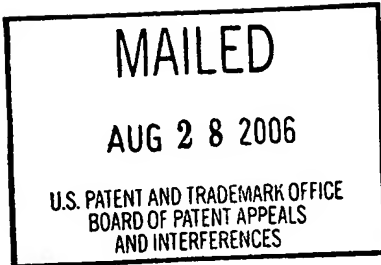


UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ULRICH REICHSTEIN, OSWALD DACHS, GERD WARNECKE,
BODO STANGE and MATTHIAS KANTER

Application 10/603,459

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on August 12, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are listed below:

(1) The Examiner's Answer mailed May 8, 2006 does list the prior art of record being relied upon in the rejections. Page 2 of the examiner's answer contains a section heading titled **"(8) Evidence Relied Upon"** that states "[n]o evidence is relied upon by the examiner in the rejection of the claims under appeal". The Manual Of Patent Examining Procedure (MPEP) § 1207.02(A) (8th ed., Rev. 3, August 2005) defines the above heading as follows:

(8) Evidence Relied Upon. A listing of the evidence relied on (e-g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

Since the examiner's §103(a) and §102(b) rejections are based on prior art references, and admitted prior art, these references and any other evidence relied upon should be listed under the **"(8) Evidence Relied Upon"** heading in the examiner's answer. Correction is required.

(2) In a Memorandum to the Technology Center Directors and Patent Examining Corps dated April 29, 2002 and entitled "Reliance upon abstracts and foreign language documents in support of a rejection," the Deputy Commissioner for Patent Examination Policy mandated that

"(e)ffective immediately, no appeal should be forwarded to the Board of Patent Appeals and Interferences for decision where . . . a rejection is supported in whole or part by a prior art document not in the English language, unless accompanied by a translation of the prior art document into English.¹

In the rejections of the claims on appeal, in addition to other prior art, the examiner has applied subject matter of foreign patents DE 199 09 307 and DE 202 04 359. However, we do not find a complete English language copy of the German patents in the application's electronic file. An English language copy of the complete references is needed.

¹ Most of the memorandum's content now appears in MPEP § 706.02 (II.).

Application No. 10/603,459

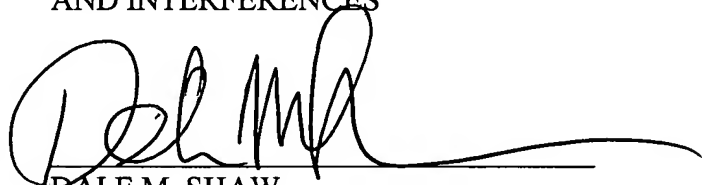
Accordingly, it is

ORDERED that the application is returned to the Examiner

- a) to issue a revised Examiner's Answer listing the prior art of record and any other evidence being relied upon in the rejection(s) of the appealed claims beneath the Evidence Relied Upon heading, and
- b) obtaining a complete English language copy of the foreign references noted above,
- c) having a copy of the translations scanned into the application IFW, and
- d) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By:



DALE M. SHAW

Deputy Chief Appeals Administrator
(571) 272-9797

DMS/vsh

cc: HENRY M FEIEREISEN, LLC
350 FIFTH AVENUE
SUITE 4714
NEW YORK NY 10118